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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,534	02/03/2003	Catia Bastioli	13929/T/B/A	7100

7590

05/05/2005

Bryan Cave  
245 Park Avenue  
New York, NY 10167

EXAMINER
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PEARSE, ADEPEJU OMOLOLA

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/936,534	<b>Applicant(s)</b> BASTIOLI ET AL.	
	<b>Examiner</b> Adepeju Pearse	<b>Art Unit</b> 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities: On page 4 of the disclosure, (paragraph 6, line 4) “from other sources” is unclear and should be expanded on by giving examples. Also, on page 5 of the disclosure (1<sup>st</sup> paragraph, line 2-3) “ The material thus produced can be processed by known techniques” should be further explained by giving examples of techniques to process the material.

Appropriate correction is required.

2. Claims 5-8 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim --should refer to other claims in the alternative only--, and/or--, cannot depend from any other multiple dependent claim--. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claim 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claim 1, the word “typically” is not clear. In line 3, the word “comprising” is suggested to be removed.

5. With regards to claim 4, wrong Markush grouping format is used. The word “comprising” should be --consisting of-- Applicant should refer to MPEP section 803.02.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leo (U.S. Patent 5,419,283) in view of Van Loo et al. (U.S. Patent Number 6,500,805 B2) and Tomka (U.S. Patent Number 5,844,023). With regard to claim 1, Leo discloses in (Col 1, lines 28-31) an article for pets, specifically dogs and cats made from starch with a thermoplastic polymer. However, Leo does not show an article made from inulin. With regards to claim 2, Leo discloses in (col 1, line 33-35), an article preferably made from a thermoplastically processable starch with thermoplastic polymer. However, Leo does not show an article made from a thermoplastically

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processable inulin. With regards to claim 3, Leo discloses in (col 1, line 30) preferred articles made from biodegradable thermoplastic polymers. With regards to claim 4, Leo discloses in (col 2, lines 59-62), an article made from a degradable polymer consisting of starch. Van Loo et al. (U.S. Patent Number 6,500,805 B2) teaches a fructan composition preferably inulin as a functional food that can be administered in any food form including a pet food and the like. With regards to claim 9, Leo fails to disclose a thermoplastically processable inulin or mixtures of inulin. However, Tomka (U.S. Patent Number 5,844,023) discloses a thermoplastically processable starch with thermoplastic polymer. (Col. 15, lines 23-29). Therefore, it would have been obvious to one of ordinary skill in the art to modify Leo (U.S. Patent Number 5,419,283) with Tomka and Van Loo et al. because inulin is known for its nutritional properties and beneficial effects on the digestive tract, effects on lipid metabolism and preventive effects against cancer, especially colon cancer in mammals.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adepeju Pearse whose telephone number is 571-272-8560. The examiner can normally be reached on Monday through Friday, 8.00am - 4.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peju Pearse  
Art Unit 1761

Steven Weinstein  
**STEVE WEINSTEIN** 1761  
**PRIMARY EXAMINER**  
For M. Cano